

Applicants: Han Htun and Gordon L. Hager

U.S. Serial No. 10/001,486

Filed: November 15, 2001

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REMARKS

Claims 16-18 are pending and being examined. Applicants have amended claim 16. Entry of these amendments is respectfully requested.

Support for amended claim 16 may be found in originally filed specification at page 7, line 21; page 8, line 3, line 6, and line 15; page 28, line 28; page 29, line 5 and lines 15-16 and page 59, lines 3-7.

Applicants have amended claim 16 herein. The changes in claim 16 do not involve new matter, and are supported by the specification as originally filed. Entry of these amendments is respectfully requested.

INCORPORATION BY REFERENCE

In paragraph 1-4, the Examiner objected to the specification. Allegedly, the cited documents are not considered to have been properly incorporated by reference and as such have not been considered with any effect towards their fulfilling, in the whole or part, the enablement, written description, or best mode requirements of 35 U.S.C. §112.

In response, Applicants hereby delete the paragraph in the specification.

REJECTION OF THE CLAIMS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

In paragraphs 5 and 6, at page 4 of the Office Action, the Office rejects claim 18, under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention. In particular, the Office contends that the cell line 3134 deposited as ATCC CRL-11998 is a required element to practice the invention. Accordingly, the Office is

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requiring Applicants to provide assurance that the ATCC deposit of the cell line be made readily obtainable to the public. The Office states that Applicants can obviate this rejection by providing assurance of the availability of the deposit and a showing that the deposit was made under the terms of the Budapest Treaty.

In response, Applicants provide the following statement of assurance.

Statement of ATCC Deposit:

Applicants' patent representative maintains that the cell line disclosed in the present application is the same as that designated ATCC Accession No. CRL-11998 (specification as originally filed at page 17, line 23) which has been deposited pursuant to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure with the Patent Culture Depository of the American Type Culture Collection (ATCC), 10801 University Blvd., Manassas, Virginia 20110-2209 U.S.A.

Accordingly, Applicants maintain that during the pendency of the present application, access to the ATCC deposit will be afforded to one determined by the Commissioner to be entitled thereto under 35 U.S.C. §1.14 and §122, and all restrictions on the availability to the public of the material deposited under ATCC Accession No. CRL-11998 will be irrevocably removed upon the issuance of a patent from the present application. Furthermore, the above deposits will be maintained by the ATCC for a period of 30 years from the date of deposit or at least 5 years after the last request for a sample of the deposited material, whichever is longer. Where the ATCC cannot furnish samples of the above deposits for any reason, Applicants shall make a replacement deposit, of the material which was originally deposited, within three months of receiving notification that the ATCC cannot furnish samples.

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REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

In paragraphs 7-14, the Patent Office rejected claims 16-18 under 35 U.S.C. §112, second paragraph because these claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention

Specifically, in item 9, the Examiner rejected the recitation of “having a nucleus” in claim 16 as confusing and redundant. Allegedly, all mammalian cells are nucleated.

In response, Applicants respectfully point out that not all mammalian cells are nucleated. For example, red blood cells are non-nucleated mammalian cells.

In item 10, claim 16 is confusing in its recitation of “the steroid receptor response element is.”

In response, applicants have amended the claim to recite “the steroid receptor response element comprises a plurality of....” (specification at page 17, lines 10-23).

In item 11, claim 16 is confusing as to what constitutes an “array such that the response element can be directly detected.”

In response, applicants have removed the word “directly.”

In item 12, claim 16 is confusing as to how one detects a change in relative fluorescence when but one measurement is conducted.

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In response, Applicants respectfully point out that at least two measurements are made (specification at page 47, lines 17-24).

In item 13, claim 16 is unclear as to the phrase "such as."

In response, claim 16 has been amended to remove "such" and replace it with "so."

In item 14, claim 17 recites "the fluorescent protein". There is no antecedent basis for such recitation.

In response, Applicants have amended claim 17 to recite "wherein the fluorescently labeled steroid receptor is fluorescently labeled with a green fluorescent protein."

CONCLUSION

Applicants believe that all grounds for rejection of the claims have been successfully overcome and that the claims are now in condition for allowance. Withdrawal of the Examiner's remaining rejections is requested and prompt allowance of the claims is solicited. If any issues remain in connection with the claims, the Examiner is encouraged to contact the undersigned by telephone to discuss the same.

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No fee, other than the \$225.00 two-month extension fee, is deemed necessary in connection with the filing of this Amendment. If any further fee is necessary, the Patent Office is authorized to charge any additional fee to Deposit Account No. 50-0306.

Respectfully submitted,

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